

REMARKS

The Examiner has objected to claims 33-38 because of informalities stating:

“a) Claims 33-35 recite, ‘An integrated circuit’. ‘An integrated circuit’ in the preamble. CFR § 1.75 states that the specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter, which the applicants regard as his invention or discovery. An integrated circuit does not indicate what subject matter the claims are directed to. The [Examiner] suggests that following --- An integrated circuit for performing a stress testing comprising ---

b) Claims 36-38 recite, ‘A method’. ‘A method’ in the preamble. CFR § 1.75 states that the specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter, which the applicants regard as his invention or discovery. A method does not indicate what subject matter the claims are directed to. The [Examiner] suggests that following --
- A method of stressing an integrated circuit, comprising --

c) Please change the phrase ‘clock signal is in a a (b) state ‘ ---to--- ‘clock signal is in a (b) state.’ (see claim 33 line 6).”

In response, Applicants have amended the preambles of claims 33-35 to recite “An integrated circuit for performing stress testing, comprising:” and have amended the preambles of claims 36-38 to recite “A method for stress testing an integrated circuit, comprising:.” Applicants have also removed the second “a” from line 6 of claim 33.

The Examiner rejected claims 33 and 36-38 under 35 U.S.C. §112(second paragraph).

The Examiner rejected claims 2-4, 8-9, 12-14, 16, 18-20, 24, 25, 28-30 and 33-42 under 35 U.S.C. 103 as being unpatentable over Radjassamy (U.S. 6,331,800) in view of Tsukamoto et al. (U.S. 5,930,269).

Applicants respectfully traverse the §112, and §103 rejections with the following arguments.

35 USC § 112

The Examiner rejected claims 33-38 under 35 U.S.C §112, (second) paragraph stating:

"Claims 33 and 36-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 33 recites 'said circuit' in line 8 (Note: it is not clear whether 'said circuit' refers to 'first circuit' in line 2. There is insufficient antecedent basis for this limitation in the claim.

b) Claims 36-38 recite the limitation 'said integrated circuit' in line 2. There is insufficient antecedent basis for this limitation in the claim. Note: 'the said integrated circuit' is unknown or undefined element in claims 36, 37 and 38.

In response, Applicants have amended claims 33, and 36-38 to ensure proper antecedent basis in claims 33 and 36-38.

35 USC § 103 Rejections

In the amendment filed on April 20, 2005, Applicants pointed out that claims 33-38 require (1) clocks having high and low periods that do not overlap, (2) the clocks to control whether or not power is supplied to the power rails and (3) for claims 36-38 that the latches, circuits and power rails be on a single integrated circuit, none of which features are taught or suggested in the combination of Radjassamy in view of Tsukamoto et al.

In the Examiners Office Action of May 18, 2005, the Examiner stated: " In response to applicants' argument that the references fail to show features of applicants' invention, it is noted that the features upon which applicant relies are not recited in the rejected claims(s). Although, the claims interpreted in light of the specification, limitations from the specification are not read to the claims. Se *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). For example, the applicants argues that the prior arts do not show clocks having high a low periods that do not overlap and the clocks control whether or not power is supplied to the power rails (as in claims 33-38) and circuit and power rails be on a single integrated circuit (as in claims 36-38) are non-claimed in the claimed."

On July, 11th 2005, in a telephone interview, Anthony M. Palagonia, the Applicants Representative, and the Examiner discussed the above said limitations and the Examiner indicated he would look favorably on the inclusion in claims 33-38 of the limitations of (1) clocks having high and low periods that do not overlap and (2) the clocks to control whether or not power is supplied to the power rails. Applicants have so amended claims 33-38 to include limitations (1) and believe limitations (2) were implied in claims 33-38 but have attempted to clarify this limitation.

For example, Applicants contend that claims 33-38 are not obvious in view of Rajassamy in view of Tsukamoto et al. because Rajassamy in view of Tsukamoto et al. does not teach or suggest every feature of claims 33-38. In a first example, Rajassamy in view of Tsukamoto et al. does not teach or suggest "powering said first power rail when a first clock signal is in an (A) state and de-powering said first power rail when said first clock signal is in a (1-A) state, where A is equal to 0 or 1;" Applicants point out, that there is no teaching in either Rajassamy or Tsukamoto et al. of powering or de-powering the power rails based on the state of the clocks.

In a second example, Rajassamy in view of Tsukamoto et al. does not teach or suggest "low states of said first clock signal not overlapping high states of said second clock signal and low states of said second clock signal not overlapping high states of said first clock signal."

The Examiner respectfully directed to FIG. 3 and particularly to FIG. 5 of Rajassamy, which clearly shows overlapping high and low states of clocks CK1N and CK2N and which is a requirement for the invention of Rajassamy to function.

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invite the Examiner to contact the Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0456.

Respectfully submitted,
FOR: Bernstein et al.

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